

## REMARKS

This Amendment is filed in response to the Office Action of July 7, 2005. Previously, claims 35-67 were pending in this application. By this Amendment, Applicants have amended claims 35, 45 and 54 to better define the presently claimed invention. The amendments to these claims were made for clarification and are not intended to narrow the scope of the claims. New claims 68-74 are now being presented. Applicants respectfully request reconsideration of all the pending claims in view of the remarks presented below.

Initially, the Examiner has rejected claims 38 and 48 under 35 U. S. C. 112, first paragraph. Applicants note that the Specification has now been amended to state that the column strength of the inner catheter could be greater than the recovery sheath. Applicants rely on the disclosure of claims 38 and 48 to support the amendment to the Specification. Therefore, it is believed that no new matter has been introduced into the application. The column strength of the recovery sheath can certainly be less than the inner catheter and will track over the inner catheter while still being sufficiently strong to collapse the expanded filter. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 38 and 48 under 35 U. S. C. 112, first paragraph.

Claims 35-40, 42-50, 52-67 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,171,327 to Daniel et al. ("the Daniel patent"). Applicants note that the amendment to pending claims 35, 45 and 54 now recite an inner catheter having a distal portion that includes a length of flexible tubing having sufficient length to allow the distal end of the recovery sheath to track thereover and reduce the possibility that the recovery sheath will straighten the body vessel when deployed in a

curved portion of the body vessel. Applicants strongly disagree with the Examiner's position that the catheter shown in the Daniel patent somehow tracks over the component which the Examiner has identified as constituting the flexible length of tubing that forms the distal end of the inner catheter. The Examiner has taken the position that the short tapered portion 180 which extends distally beyond the recovery sheath (150) constitutes the distal end of the inner catheter. However, this tapered portion 180 extends outside of the recovery housing only a short distance and is merely designed to provide a relatively soft and atraumatic tip. However, due to its tapered structure, the outer catheter of the Daniel device does not even contact this tapered tip at all. Therefore, the outer catheter does not track over this distal tip portion in any manner. Moreover, this tip portion 180 certainly does not function in any manner to reduce the possibility that the recovery sheath will straighten the body vessel when advance along the inner catheter when placed in a curved portion of the body vessel.

Applicants' presently claimed invention provides this length of flexible tubing to allow the outer catheter to track thereover to minimize the possibility of the blood vessel straightening as the larger diameter recovery sheath is advanced over the distal portion of the inner catheter. (see page 17, paragraph 28 of Applicants' specification). Such an arrangement of an outer catheter tracking over an inner catheter to reduce straightening of the body vessel is simply not shown in the Daniel patent. Also, in use, the outer catheter of the Daniel device does not even appear to move distally over this tapered tip portion 180 at all. Rather, it appears that the inner catheter actually is retracted proximally to

move the expanded filter back into the retrieval housing 152 of the outer catheter 150. Therefore, the outer catheter of the Daniel patent remains stationary relative to the inner catheter as the two catheters are moved into to body vessel. Once in positioned in the vessel, the outer catheter remains stationary as the inner catheter is retracted proximally to retrieve the expanded filter. This is yet another reason why the outer catheter of the Daniel patent does not, and cannot, track over this tapered tip portion 180. Accordingly, Applicants believe that the presently claimed invention is neither shown nor suggested in the Daniel patent. Applicants respectfully request the Examiner to withdraw the Daniel patent as an anticipatory reference.

Claims 41 and 51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Daniel patent in view of U.S. Patent No. 5,201,757 to Heyn et al. ("the Heyn patent"). In view of the remarks addressed above with respect to the presently claimed invention defined by claims 35 and 45, it is believed that the particular combination of the Daniel patent with the Heyn patent fails to achieve the claimed structure. Applicants respectfully request the Examiner to withdraw the obviousness rejections against claims 41 and 51.

Finally, newly presented claims 68-74 are believed to be patentable over the Daniel patent for the same reasons that claims 1 and 45 are patentable over that reference.

The Examiner has rejected claims 35-38, 45-48 and 54-57 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1- 17 of U. S. Patent No. 6,569,184. While Applicants believe that the claims at issue

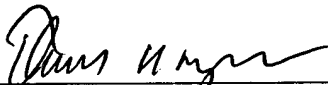
have completely different scope, Applicants submit herewith a Terminal Disclaimer to place this case in a condition for allowance.

In view of the foregoing, it is respectively urged that all of the present claims of the application are patentable and in a condition for allowance. The undersigned attorney can be reached at (310) 824-5555 to facilitate prosecution of this application, if necessary.

In light of the above amendments and remarks, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

FULWIDER PATTON LEE & UTECHT, LLP

By:   
Thomas H. Majcher  
Registration No. 31,119

THM:gbr  
Howard Hughes Center  
6060 Center Drive, Tenth Floor  
Los Angeles, CA 90045  
Telephone: (310) 824-5555  
Facsimile: (310) 824-9696  
Customer No. 24201  
96115.1